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In re Application of
EULER et al.
Application No.: 09/762,863
PCT No.: PCT/US99/19601
Int. Filing Date: 25 August 1999
Priority Date: 26 August 1998
Attorney's Docket No.: 4463
For: THIN FILM STRAIN SENSORS BASED ON
INTERFEROMETRIC OPTICAL MEASUREMENTS

DECISION ON

PETITION UNDER

37 CFR 1.47(a)

This is a decision on applicants' "Renewed Petition Under 37 C.F.R. 1.47(a)" including a Statement of Facts in Support of Filing on Behalf of Nonsigning Inventor under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 08 January 2002, in response to a decision mailed on 07 September 2001. The petition requests the acceptance of the application without the signature of named inventor, Gregg S. Huston.

BACKGROUND

On 14 February 2001, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, basic national fee.

On 08 March 2000, a Notification of Missing Requirements was mailed to applicants indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and requisite surcharge for filing the oath or declaration after the 30-month period was required. The Notification set a time period within which to respond and allowed for extensions of time under 37 CFR 1.136(a).

On 02 May 2001, applicants filed a petition in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition, in effect, requested status under 37 CFR 1.47(a) on the grounds that third-named inventor, Gregg C. Huston, was unavailable. Submitted with the petition, *inter alia*, was the declaration of William B. Euler, the first named inventor in the above referenced application.

In a decision mailed 07 September 2001, applicants were advised that the petition to accept the application without the signature of Gregg C. Huston was dismissed because the

requirements of 37 CFR 1.47(a) had not been met. The decision set a two month deadline for response or by 07 December 2001, with extensions of time available under 37 CFR 1.136(a).

On 08 January 2002, applicants filed this renewed petition under 37 CFR 1.47(a) and correction of inventor Gregg C. Huston's middle initial. No certificate of mailing was filed with the renewed petition. Since the response was received in the USPTO more than four months after the mail date of the decision, a three (3) month extension of time is required. The \$460 fee for a three month extension of time for a small entity will be charged to applicant's deposit account #19-0079 per his authorization.

DISCUSSION

As previously noted, a petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Applicants previously satisfied Item (1) with the payment of the petition fee but had not satisfied items (2)-(4).

With regard to Item (3), attorney of record Richard L. Stevens attests that the middle name of inventor Gregg Huston as well as the number of his residential address were typed incorrectly on the application. Mr. Stevens indicates that the correct middle name and correct address are set forth in paragraph 2 of Mr. William B. Euler's declaration dated 02 May 2001. Paragraph 2 of the Euler declaration states: the last known address of Mr. Gregg S. Huston is 23 Tomahawk Trail, Wakefield, Rhode Island 02879. Mr. Stevens' explanation that the incorrect middle initial and street number was a typographical error is accepted. Item (3) above is satisfied.

Regarding item (4) above, applicants have provided a declaration executed by co-inventors William B. Euler and Gregory J. Otto on behalf of nonsigning inventor, Gregg S. Huston. In light of the explanation of the typographical error in the application with regard to Mr. Huston's middle initial given by counsel of record as indicated above, Item (4) is now satisfied.

The declaration of attorney Stevens indicates that on 01 October 2001, a copy of the above identified application and declaration and power of attorney was mailed to Mr. Huston at his last known address via certified mail. The envelope was returned undeliverable by the United States Postal Service with the notation "Moved, Left No Address". Counsel has not described what steps were taken to locate the whereabouts of the nonsigning inventor, i.e. Internet searches, contacts with his last known place of employment to locate a current employer or address. See MPEP 409.03(d) Inventor Cannot Be Reached. Without a statement

of facts by a person having first hand knowledge concerning the facts regarding such "diligent efforts", the petition under 37 CFR 1.47 cannot be granted.

Applicants have fulfilled the requirements of items (3) and (4) above. However, item (2) is not satisfied. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR 1.47(a) at this time.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice. Applicant's deposit account no. 19-0079 will be charged for a three month extension of time or \$460 for a small entity.

Should status under 37 CFR 1.47(a) not be successfully completed, the international application will be viewed as having become abandoned with respect to the United States.

Any reconsideration on the merits of this petition must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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